

Attorney Docket No. 5470.255
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REMARKS

Claims 1, 3-7, 13-16 and 49 are pending in this application. Claims 3-7, 13-16 and 49 are amended herein for clarity to more particularly define the invention. The specification is amended herein to remove a hyperlink and to update the address of the American Type Culture Collection, as requested by the Examiner. Support for these amendments is found in the language of the original claims and throughout the specification, as set forth below and no new matter has been added by these amendments. In light of these amendments and the following remarks, applicants respectfully request reconsideration of this application and allowance of the pending claims to issue.

I. Objections to the specification

A. The Office Action states that the use of trademarks has been noted in the specification and provides the particular examples: "Invitrogen" on page 31, "Promega" on pages 32 and 53 and "Immunex" on page 32.

Applicants respectfully point out that the three particular examples cited in the Office Action are all names of companies and their inclusion in the specification as referenced is for the purpose of identifying them as a supplier of particular reagents, kits and materials available to practice the invention. Applicants also note that several other company names are recited in the specification for the same purpose (e.g., Pharmacia & Upjohn (page 32); U.S. Biochemical Corp. (page 32); Boehringer Mannheim (page 51); Stratagene (page 51); Gibco-BRL (page 52); Pierce (page 52); Neomarker (page 52); Sigma (page 54), etc.). As it is applicants' understanding that the use of these names in the specification to identify them as suppliers of reagents and other materials does not constitute their use as trademarks, applicants believe it is unnecessary to amend the specification to identify them as such. However, if the Examiner can provide to applicants some evidence that serves as a basis for interpreting the recitations of these companies in the specification in the context described as a use of a trademark, applicants would be happy to consider such evidence and amend the specification accordingly.

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B. The Office Action states that the specification is objected to because it contains an embedded hyperlink on page 21.

Page 21 of the specification is amended herein to delete the hyperlink, thereby overcoming this objection and applicants respectfully request its withdrawal.

C. The Office Action states that the specification is objected to because the address for the American Type Culture Collection on page 29 is not current.

Page 29 of the specification is amended herein to update the address, as requested by the Examiner. Thus, this objection has been overcome and applicants respectfully request its withdrawal.

II. Oath/Declaration

The Office Action states that the Declaration is defective due to an inconsistency in the identification of the application number of the provisional application to which the present application claims priority.

Included herewith is an executed Declaration that lists the correct application number for the provisional application to which the present application claims priority. Thus, this objection has been overcome and applicants respectfully request its withdrawal.

III. Priority

The Office Action states that acknowledgement is made of a claim for domestic priority under 35 USC § 120 or 121 to US application number 60/127261 filed on March 31, 1999 and that SEQ ID NOs:1 and 2 have been disclosed in this provisional application.

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Applicants appreciate the acknowledgement of this priority claim, but point out that it is made pursuant to 35 USC § 119(e).

IV. Rejection under 35 USC § 102(e)

The Office Action states that claims 1, 3-7, 13-16 and 49 are rejected under 35 USC § 102(e) as allegedly anticipated by Edwards et al. (U.S. Patent No. 6,783,961). Specifically, the Office Action states that Edwards et al. teach a polynucleotide encoding the polypeptide of SEQ ID NO:2 of the instant invention, thereby allegedly anticipating claims 1 and 3, as well as claims 5-7, 13-16 and 49.

The Office Action goes on to state that claim 4 is directed to a polynucleotide consisting of SEQ ID NO:1 and that while the polynucleotide of Edwards et al. does not consist of SEQ ID NO:1, Edwards et al. teaches that the polynucleotide of SEQ ID NO:3894 encodes a polypeptide having the same length and sequence as that of polypeptide of SEQ ID NO:2 of the instant application and it also teaches fragments of the polynucleotide of SEQ ID NO:3894 wherein said fragments encode the full-length protein. The Examiner further contends that Edwards et al. teaches the cDNA corresponding to the polynucleotide of SEQ ID NO:3894 and that SEQ ID NO:1 of the instant application corresponds to the coding region of the polynucleotide of Edwards et al. and that therefore, the teachings of Edwards et al. would anticipate the instant claims as written.

The Office Action further states that the 102(e) date for the Edwards et al. patent is February 26, 1999.

Although applicants do not agree with or acquiesce to the Examiner's assessment that the Edwards et al. patent does or "would" anticipate the claimed invention, this rejection is rendered moot on the basis that applicants provide herein a Declaration under 37 C.F.R. § 1.131 providing evidence

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that the claimed invention was conceived and reduced to practice prior to February 26, 1999.

Specifically, the enclosed Declaration states that prior to February 26, 1999, the inventors conceived and reduced to practice the compositions and methods recited in the pending claims. In support of this statement, enclosed as Appendix A, is a copy of a letter from co-inventor, Dr. Yue Xiong, to Dr. Brownen Nishikawa, a technology development associate in the Office of Technology Development at the University of North Carolina at Chapel Hill, explaining that a manuscript is enclosed with this letter that describes the discovery and functional characterization of two novel human genes, ROC1 and ROC2. A copy of the manuscript referenced in the letter is also enclosed as Appendix B. All dates on these documents have been blocked out, but are before February 26, 1999.

The Declaration further states that the manuscript enclosed with the above-described letter is a draft of the manuscript which formed the basis of the present specification and that was subsequently published (Ohta et al. "ROC1, a homolog of APC11, represents a family of cullin partners with an associated ubiquitin ligase activity" *Molecular Cell* 3:535-541 (April, 1999)). As indicated in the figure legend on page 34 of the draft of the manuscript and in the attached figures, the nucleotide sequence and amino acid sequence of the ROC1 protein disclosed therein is identical to the nucleotide sequence and amino acid sequence of the ROC1 protein disclosed in the present application as SEQ ID NOs:1 and 2, respectively.

The Declaration provides evidence that the inventors conceived and reduced to practice the claimed invention prior to the February 26, 1999 priority date of the Edwards et al. patent. Thus, Edwards et al. patent is not available as a prior art document against the pending claims and this rejection has been overcome. Thus, applicants respectfully request its withdrawal and allowance of the pending claims to issue.

The concerns of the Examiner having been addressed in full, Applicants respectfully request withdrawal of all outstanding rejections and the issuance of a Notice of Allowance forthwith, on the

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basis of the Examiner's previous indications that the claims are directed to allowable subject matter. The Examiner is invited encouraged to address any questions regarding the foregoing to the undersigned attorney, if such contact will expedite the prosecution of the pending claims to issue.

No fee is believed due with this response. However, the Commissioner is authorized to charge any deficiency or credit any overpayment to Deposit Account 50-0220.

Respectfully submitted,

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I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Tracy Wallace